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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/534,976

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Soichiro Watanabe

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EXAMINER

MERCIER, MELISSA S

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/534,976

Applicant(s)

WATANABE, SOICHIRO

Examiner

Melissa S. Mercier

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8-4-05, 5-16-05</u> | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### **Summary**

Claims 1-10 are pending in this application. Claims 1-10 are rejected.

### ***Priority***

Applicants claim of priority to PCT/JP03/12773 filed on 10/06/2003 is acknowledged.

### ***Information Disclosure Statement***

Receipt of the Information Disclosure Statements received on May 16, 2005 and August 4, 2005 is acknowledged.

### ***Specification***

The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

### ***Claim Objections***

Claims 5-10 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim 4. See MPEP § 608.01(n).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Claims are indefinite because they dependent on other multiple dependent claims. It is unclear what the limitations and scope of the claims are. It is the examiners duty to examine the claims with their broadest possible interpretation, therefore, the examiner is interpreting the dependent claims to all depend off claim 1, which is the broadest claim presented. The examiner in interpreting Claim 5 to be dependent on Claim 1 via 4, Claim 6 is dependent on Claim 1, Claim 7 is dependent on claim 1 via 6, Claims 8-10 are dependent on Claim 1.

Claim 10 recites the limitation "the anionic surfactant" in line 2. There is insufficient antecedent basis for this limitation in the claim. It is the examiners position that Claim 10 is only dependent on Claim 1, which does not comprise an anionic surfactant.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 rejected under 35 U.S.C. 102(b) as being anticipated by Mizuguchi et al. (US Patent 5,520,917).

Mizuguchi teaches “a colored particulate material in the form of almost perfectly spherical fine particles comprising an organic and/or inorganic pigment coated with a hydrated metal compound over the surface thereof, the coated pigment being enclosed with an inorganic porous wall substance, process for producing the same, and a cosmetic composition comprising the same” (abstract). Examples of pigments for use are inorganic pigments including: titanium dioxide and titanium black (column 3, line 44). Mizuguchi discloses, “the pigment is coated with a hydrated metal oxide. The hydrated metal oxide can be titanium dioxide” (column 5, lines 23-26).

The cosmetic composition of Mizuguchi has incorporated therein the colored particulate material in an amount of 0.1 to 50 wt. % based on the whole weight of the composition” (column 10, lines 25-30).

Mizuguchi's example 15, discloses the use of 10.0% polyvinyl alcohol (column 19).

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Regarding Claim 2, "the surfactant to be used is a nonionic surfactant" (column 7, line 53).

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Leverett (US Patent 6,132,739).

Leverett discloses, a "makeup compositions having enhanced transfer resistance including at least one hydrophilic film former. The makeup can be a water-in-oil emulsion having the hydrophilic film former in the internal water phase and at least one pigment in the external oil phase. The makeup composition can also be a suspension of one or more cationically coated pigments in water in which the hydrophilic film former is dissolved. The hydrophilic film former may also be an anionic gelling agent, whereby the cationically-coated pigment and the anionic gelling agent form a water-dispersible complex that upon application to the skin forms an insoluble pigmented salt having enhanced transfer resistance" (abstract).

Leverett discloses, "the oil phase includes one or more oil-dispersible pigments, such as titanium oxide" (column 3, lines 50-58). The effective amount is from about 3% to about 30% weight of the composition (column 3, lines 62-66). Additionally, Leverett teaches, water-dispersible micron sized titanium dioxide particles can be added" (column 5, lines 45-50).

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Leverett further teaches, "the water phase comprises a hydrophilic film former, polyvinyl alcohol" (column 4, lines 44-48). Effective amounts of the hydrophilic film former are from 0.1 to about 8%. (column 5, lines 10-16).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2, 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizuguchi et al. (US Patent 5,520,917).

Mizuguchi teachings as they apply to Claim 1 are discussed above and applied in the same manner.

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Regarding Claims 6-7, it would be within the knowledge of the person of ordinary skill in the art to chose a component that will offer specific properties to prepare a composition with the desired properties and qualities desired.

It would have been obvious to a person of ordinary skill in this art at the time the invention was made to have expanded upon the teachings of Mizuguchi in order to prepare a cosmetic composition capable of "producing a vivid color free from irregularities and suitable beautifying effects as in respect of tinting strength and hiding power and which is smoothly spread able when applied and excellent in sustained beautifying effects such as retention of the color without dulling despite lapse of time" (column 2, line46-54).

Claims 1, and 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terasse et al. (US Patent 6, 077,341).

Terasse teaches, "metal oxide particulates of a metal oxide other than silica, for example, include titanium dioxide. They may be selected for use depending upon the particular purpose. For example, in a case where a substantial ultraviolet ray-shielding function is required, particulates of titanium dioxide. They may be used alone or in combination as a mixture of two or more of them" (column 2, lines 54-68, column 3, lines1-6). The amount of the metal oxide particulates in the composite is preferably from 1 to 80 wt % (column 3, lines 29-30).

Terasse further discloses, "when the metal oxide particulates have an ultraviolet-shielding function, the composite may be incorporated as an ultraviolet ray-shielding



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agent to cosmetics, coating materials or resins (column 13, lines 39-44). in the case where it is to be incorporated to a coating material, the resin for a coating material may, for example, be a polyvinyl alcohol" (column 14, lines 1-8).

Regarding Claims 4-5, Terasse teaches a composition in which silica agglomerates of a specific shape having voids formed by random stacking of scaly silica primary particles, are used as silica agglomerates having the above-described metal oxide particulates supported on their surfaces" (column 4, lines 6-10). It is the examiners position that the silica particles are an amorphous silicic anhydride compound

Terasse does not disclose the percentage of polyvinyl alcohol to be used in the composition.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have expanded upon the teaching of Terasse to make a composition which would "not undergo deterioration with time by direct oxidation of ultraviolet rays (column 1, lines 26-30). It would be within the skill of a person of ordinary skill in the art to modify the percentages of resin present in order to obtain the desired qualities and properties through routine experimentation.

Claims 1-3 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leverett (US Patent 6,132,739) in view of Guerrero (US Patent 5,609,854).

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Leverett teachings as they apply to Claim 1 are described above and applied in the same manner.

Leverett does not disclose the use of an anionic surfactant, types of anionic surfactants, the use of ascorbic acid, the use of emollients.

Guerrero teaches a thickened and stabilized cosmetic emulsion composition.

Regarding Claims 2-3, Guerrero discloses, "surfactants can be included in the composition. Preferred anionic surfactants include soap, alkyl ether sulfate and sulfonates, alkyl sulfates and sulfonates, alkylbenzene sulfonates, alkyl and dialkyl sulfosuccinates" (column 5, lines 40-43).

Regarding Claim 8, Guerrero discloses, "an essential element of the compositions according to the present invention is that of an aluminum salt including ascorbic acid" (column 3, lines 7-17). Guerrero further discloses, "minor adjunct ingredients may include vitamin C, also known as ascorbic acid" (column 6, lines 7-10).

Regarding Claim 9, Guerrero's composition comprises polyglycerol fatty acid esters as emollients. (column 2, lines 62-65).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the teachings of Leverett with the thickeners and stabilizers of Guerrero in order to achieve an aesthetically pleasing viscosity. Guerrero discloses "fluids that flow with a watery consistency too rapidly run off the treated skin areas. For cosmetics to be effective, it often must have substantivity" (column 1, lines 12-20).

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The applicants would have a reasonable expectation that the new composition would function as a cosmetic composition, since both references teach a cosmetic composition.

Claims 1-2 and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Leverett (US Patent 6,132,739) in view of Kisuno et al. (US Patent 5,889,088).

Leverett's teachings as they apply to Claim 1 are described above and applied in the same manner.

Leverett does not disclose the use of an anionic surfactant, in particular the use of dioctyl sodium sulfosuccinate.

Kisuno teaches, "an aqueous suspension of composite particles and a process for producing the same" (column 1, lines 7-10).

Kisuno discloses anionic low molecular weight surfactant compounds can be selected from sulfosuccinate acid salts. The sulfosuccinic acid salts include dioctyl sodium sulfosuccinate" (column 8, lines 53-55).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the composition of Leverett with the surfactant teachings of Kisuno in order to obtain a composition which when stored in a state of a suspension in an aqueous medium, or the aqueous medium is used as a starting material, exhibits a high storage stability over a long time and even when a portion of the particles have precipitated out" (column 2, lines 29-38).

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The applicants would have a reasonable expectation that the new composition would function as a cosmetic composition, since both references teach a cosmetic composition.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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